

Relevant Documents from **'073 Application**



Enzo Biochem, Inc.
575 Fifth Avenue
New York, NY 10017
212.856.0876
Fax: 212.856.0878

VIA FACSIMILE & FEDERAL EXPRESS
703-415-1618

March 11, 1993

Cantwell & Paxton, Inc.
Suite 1003
2001 Jefferson Davis Highway
Arlington, VA 22202

Attention: Mmes. Pat Paxton and Beverly Floyd

RE: U.S. Patent Application Serial No. 07/869,073
Filed: April 10, 1992
Inventor: Pravinkumar B. Sehgal
Title: Species of Interferon, A Process for Their
Preparation and Species of Interferon Prepared Thereby
Our Reference: Enz-2 (C3)

Dear Pat and Beverly:

Could you let me know, preferably by facsimile confirmation, the status of the above-identified U.S. application which was re-filed last April? We have received no correspondence except for the Filing Receipt issued in June 1992. For your use in making this inquiry, we have enclosed an executed Power to Inspect and Make Copies.

In addition, could you please file the following documents in connection with this application:

1. Change of Correspondence Request;
2. Request to Correct Filing Receipt; and
3. Revocation of Previous Powers of Attorney and Appointment of New Power of Attorney.

Mmes. Pat Paxton and Beverly Floyd
Cantwell & Paxton
March 11, 1993
Page 2

A return postcard is also enclosed in connection with the above documents. If possible, please have the clerk of Group 1800 (or other authorized Patent Office personnel) stamp the postcards. You may return the stamped postcards to us when you send me a paid receipt for this service, for which my personal check no. 1356 for \$25.00 is enclosed. Please let me know if this amount is sufficient.

We look forward to receipt of the status information and the stamped return postcards.

Cordially,



Ronald C. Fedus
Patent Counsel

Enclosures

MEMORANDUM

To: File

From: Ronald C. Fedus

Date: March 16, 1993

Re: **Enz-2 (C3) [Interferon et al.]**
Enz-26 (C2) [Novel One Step Method et al.]
Enz-7 (C2)(P)(C2) [Soluble Assay et al.]

Mrs. Pat Paxton of Cantwell & Paxton, our Washington associates telephoned me today to inform me that the interferon application [Enz-2 (C3)] was presently in the hands of Examiner Shelly Guest. The papers effecting changes in power and correspondence address had been filed by Pat.

With respect to the two other cases, Enz-26 (C2) and Enz-7 (C2)(P)(C2), Pat indicated that these applications were in the hands of the petitions examiner(s) who should act upon them in due course.

RF



Enzo Blochem, Inc.

575 Fifth Avenue

New York, NY 10017

212.856.0876

Fax: 212.856.0878

March 17, 1993

Dr. Pravinkumar B. Sehgal
Department of Microbiology
New York Medical College
Basic Sciences Building
Valhalla, New York 10595

Re: U.S. Patent Application Serial No. 07/869,073
Filed April 10, 1992 as a continuation of
Serial No. 07/191,517, filed May 6, 1988
Inventor: Pravinkumar B. Sehgal
For: SPECIES OF INTERFERON, A PROCESS FOR THEIR
PREPARATION AND SPECIES OF INTERFERON PREPARED THEREBY
Our Reference No.: Enz-2 (C3)

Dear Dr. Sehgal:

Further to our letter of last week, we have just been informed by our Washington associates that the new continuation application, above-identified, is presently in the hands of the patent examiner who handled the previous application.

We expect to receive a communication from the examiner in the next few weeks and will immediately apprise you when it is received.

Cordially,

A handwritten signature in dark ink, appearing to read "Ronald C. Fedus".

Ronald C. Fedus
Corporation & Patent Counsel



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/869,073 04/10/92 SEHGAL

P ENZ-2

EXAMINER

QUEST, S

ELAINE P. BRENNER
ENZO BICCHEN, INC.
60 EXECUTIVE BOULEVARD
FARMINGDALE, NY 11735

18M1

ART UNIT

PAPER NUMBER

1812

22

DATE MAILED:

03/18/93

This is a preliminary action for examination in the case of an application
for a patent in the field of PATENTS AND TRADEMARKS

RECEIVED
March 23 1993
RONALD C. FEDUS

☒ This application has been examined ☒ Responsive to communication filed on 4/10/92 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-848. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 12, 18, 23-26 are pending in the application.

Of the above, claims 12, 18, 23-26 are withdrawn from consideration.

2. ☒ Claims 1-11, 13-17, 19-22, 27-40 have been cancelled.

CONFIDENTIAL & PRIVILEGED

MEMORANDUM

To: Drs. Elazar Rabbani & Dean Engelhardt
From: Ronald C. Fedus
Date: March 23, 1993
Re: Enz-2 (C3) [Interferon et al.]

After almost one year after receiving the Filing Receipt for this application, we received the attached Office Action that was issued on March 18, 1993.

In general, the Office Action contained a number of issues which were raised in the previous application. These include:

1. lack of patentable utility (§101) page 2
2. lack of enabling disclosure
(§112, 1st ¶) pages 2-3
3. indefiniteness (§112, 2nd ¶) pages 3-4
4. anticipation (§102(a) & (f)) pages 5-6
5. obviousness (§103) pages 7-8

At the outset, I would suggest that we confer on the claims which are pending in this application for the purpose of determining their suitability in terms of language and scope.

As far as the issues raised in the Office Action, I think that the indefiniteness issue (§112, 2nd ¶) can be easily handled by minor amendments to the claims. The anticipation rejection by Weissenbach et al. can also be easily handled by a so-called Rule 131 Declaration to swear behind the reference. I have some laboratory notebook pages from Dr. Pravinkumar Sehgal and will probably need some input from the inventor in order to draft and submit a proper declaration. With respect to the anticipation rejection under §102(f), this is an issue which can likewise be handled by a declaration in the name of Dr. Sehgal as the sole inventor.

Please let me know as soon as you have had an opportunity to review the Office Action. I would like to schedule an appointment with Dr. Sehgal in the coming weeks so that we can prepare a substantial response to overcome all of the remaining issues.

RWF

P H O N E M E M O
 TO: Ron
 FROM: Sherry Cermak
 OF: Patent office
 07/86 96073
 MSG: 2 C 3
 DATE: 9/23
 AREA CODE: 703
 NO.: 308-3154
 EXT.:
 TIME:
 MESSAGE
 SIGNED:
 PHONED ☐ CALL BACK ☐ RETURNED CALL ☐ WANTS TO SEE YOU ☐ WILL CALL AGAIN ☐ WAS IN ☐ URGENT ☐

MEMORANDUM

To: File

From: Ronald C. Fedus

Date: September 24, 1993

Re: Enz-2 (C3) [Interferon et al.]

On this date I telephoned Examiner Shelly Cermak [formerly Shelly Guest] of Group 1812 [Tel. 703-308-3154] who had telephoned the day before.

Examiner Cermak was inquiring as to whether we had filed a response to the March 18, 1993 Office Action. I informed her that we were preparing to file a response but that the application became unintentionally abandoned. I also indicated to Examiner Cermak that we were taking immediate steps to revive the application, and would be filing a Petition to Revive as well as an appropriate response sometime next month.

RF



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/635,372	04/10/93	ENZO THERAPEUTICS, INC.	ENZ 21031

18M1/1004
RONALD C. FEDUS, CORP. PATENT COUNSEL
ENZO THERAPEUTICS, INC.
C/O ENZO BIOCHEM, INC.
575 FIFTH AVENUE (18TH FLOOR)
NEW YORK, NEW YORK 10017

EXAMINER	
QUEST. COMMENTS	
ART UNIT	PAPER NUMBER
1812	26

DATE MAILED:

10/04/93

NOTICE OF ABANDONMENT

This application is abandoned in view of:

- ☒ Applicant's failure to respond to the Office letter, mailed 3/11/93.
 - ☐ Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
 - ☐ Applicant's failure to timely file the response received _____ within the period set in the Office letter.
 - ☐ Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of _____ of the Notice of Allowance.
 - ☐ The issue fee was received on _____.
 - ☐ The issue fee has not been received in Allowed Files Branch as of _____.
- In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17 (l), and a verified showing as to the causes of the delay.
- If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of *Deigar Inc. v. Schuyler*, 172 U.S.P.Q. 513.
- ☐ Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by _____ as required in the last Office action.
 - ☐ The corrected and/or substitute drawings were received on _____.
 - ☐ The reason(s) below.

RECEIVED

OCT - 6 1993

10/6/93
Rd

Robert J. Hill, Jr.
ROBERT J. HILL, JR.
SUPERVISORY PATENT EXAMINER
GROUP 1800



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

07/869,073 04/10/92 SERIAL

1812 1812

ELAINE P. BRENNER
ENZO BIOCHEM, INC.
60 EXECUTIVE BOULEVARD
FARMINGDALE, NY 11735

3/23/93
RCP

1811

1812

RECEIVED

Mar 23 1993

RONALD C. FEDUS

22

03/15/93

☒ This application has been examined ☒ Responsive to communication filed on 4/10/92 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 5 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-802. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 12, 18, 23-26 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-11, 13-17, 19-22, 27-40 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 12, 18, 23-26 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable, ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved, ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

PD NO. ENZ-2
FILED 6/18/93 BY
ENZO BIOCHEM, INC.
FARMINGDALE, NY 11735

EXAMINER'S ACTION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Pravinkumar B. Sehgal)
Serial No.: 07/869,073) Group Art Unit: 1812
Filed: April 10, 1992) Exam'r: Shelly Guest Cermak
Title: SPECIES OF INTERFERON, A PROCESS FOR)
THEIR PREPARATION AND SPECIES OF)
INTERFERON PREPARED THEREBY)

June 16, 1994
575 Fifth Avenue (18th Floor)
New York, New York 10017

FILED BY EXPRESS MAIL

Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Box DAC

Attention: Office of Deputy Assistant Commissioner
for Patents
2121 Crystal Drive
Crystal Park 2 - Suite 913
Arlington, Virginia 22202

PETITION TO REVIVE
AN UNINTENTIONALLY ABANDONED
APPLICATION UNDER 37 C.F.R. §1.137(b)


Dear Sirs:

Applicant submit this Petition to the Commissioner under the provisions of 37 C.F.R. §1.137(b) to revive the above-identified application which was unintentionally abandoned.

The above-identified application became unintentionally abandoned after July 18, 1993, which was the date that a response to a March 18, 1993 Office Action was due. A copy of the Notice of Abandonment issued on October 4, 1993 is attached to this Petition as Exhibit A.

It is hereby requested that this application be revived because it was unintentionally abandoned and there was no intent to abandon the application. Submitted concurrently herewith and attached as Exhibit B is a proposed response in the form of a Request for Continuation Application Under 37 C.F.R. §1.60.

Enz-2(C3)

EXPRESS MAIL CERTIFICATE	
"Express Mail" Label No.	EF414878015
Deposit Date	JUNE 16, 1994
I hereby certify that this paper and the attachments herein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington DC 20231	
 Ronald C. Fedus	JUNE 16, 1994 Date

Pravinkumar B. Sehgal
Serial No. 07/869,073
Filed: April 10, 1992
Page 2 (Petition to Revive an Unintentionally Abandoned Application
Under 37 C.F.R. §1.137(b) - June 16, 1994)

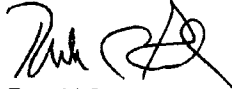
The fee for filing a Petition to Revive an Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b) is \$585.00 for a small entity. Small entity status was previously established by a duly executed Verified Statement (Declaration) Claiming Small Entity Status (37 CFR §§1.9(f) and 1.27(c)) - Small Business Concern, a copy of which accompanies the Continuation Request (Exhibit B). The Patent and Trademark Office is hereby authorized to charge Deposit Account No. 05-1135 for the requisite fee of \$585.00 set forth in 37 C.F.R. §1.17(m). The Patent and Trademark Office is further authorized hereby to charge Deposit Account No. 05-1135 for any other fees required in connection with this Petition and to credit any overpayment thereto.

A duplicate copy of this Petition (but without attached Exhibits A and B) is also submitted herewith.

Favorable action on this Petition is earnestly solicited.

If helpful to the processing of this Petition or the accompanying Continuation Request, the undersigned may be contacted by telephone during the daytime hours at 212-856-0876.

Respectfully submitted,



Ronald C. Fedus
Registration No. 32,567
Attorney for Applicant

ENZO THERAPEUTICS, INC.
c/o Enzo Biochem, Inc.
575 Fifth Avenue (18th Floor)
New York, New York 10017
Tel. (212) 856-0876



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

JLB/JVN/jlb.8

Paper No. 29

Ronald C. Fedus, Corp. Patent Counsel
Enzo Therapeutics, Inc.
C/O Enzo Biochem, Inc.
575 Fifth Avenue (18th Floor)
New York, New York 10017

COPY MAILED

AUG 31 1994

**OFFICE OF PETITIONS
IN PATENTS**

In re Application of
Pravinkumar B. Sehgal
Serial No. 07/869,073
Filed: April 10, 1992
Attorney Docket No. ENZ-2(C3)

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 16, 1994, to revive an unintentionally abandoned application.

The petition is granted.

Since this application is being revived for purposes of continuity only and since continuity has been established by this decision reviving the application, the application is again abandoned in favor of the continuing application.

If the continuing application is one filed under 37 CFR 1.60 or 1.62, applicant must file a written notice in the continuing application within ONE MONTH from the mail date of this decision indicating that the present application has been revived for purposes of continuity and, accordingly, that the continuing application complies with the copendency requirements of the rules. The failure to file such a notice may result in the continuing application being inadvertently returned to applicant.


The statement that the "abandonment was unintentional" does not comply with 37 CFR 1.137(b).¹ However, the statement presented will be accepted and construed as meaning that the "delay was unintentional." If this is an incorrect interpretation in view of the new rules, petitioner is required to provide a statement to that effect.

¹ Effective September 20, 1993. See "Changes in Procedures for Revival of Patent Applications and Reinstatement of Patents," published at 1154 Official Gazette 4 (September 14, 1993).

Serial No. 07/869,073

Page 2

The file is being forwarded to Group 1800.


Jeffrey V. Nase, Director
Office of Petitions
Office of the Assistant Commissioner
for Patents